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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/757,151	01/08/2001	James S. Boyce	10003916-1	6995

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EXAMINER

MENBERU, BENIYAM

ART UNIT	PAPER NUMBER
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2626

DATE MAILED: 10/18/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/757,151

Applicant(s)

BOYCE, JAMES S.

Examiner

Beniyam Menberu

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 22 July 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-18 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-18 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

Response to Arguments

1. Applicant's arguments, see pages 6-8, filed July 22, 2005, with respect to the rejection(s) of claim(s) 1, 7, and 13 under U.S. Patent No. 6606163 to Suzuki et al have been fully considered and are persuasive. Therefore, the rejection has been withdrawn. However, upon further consideration, a new ground(s) of rejection is made in view of U.S. Patent No. 6782402 to Hidaka et al.

Claim Rejections - 35 USC § 103

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 1, 7, and 13 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 6606163 to Suzuki et al in view of U.S. Patent No. 6782402 to Hidaka et al.

Regarding claims 1, 7, and 13, Suzuki et al disclose a method, system, and program for delivering a file from a client to a server for printing, the method comprising:

- (a) receiving a path and a name of the file (column 45, lines 5-14);
- (b) discovering a file type of the file (column 36, lines 21-29); and,
- (c) responsive to a print ready file type, initiating a write of the file to the server (Fig. 24 step s2107; If the document does not need format conversion which means it is print

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ready, then it goes to step s2111 followed by s2112 where the document is sent to printer queue which reads on writing of the file to the server.).

However Suzuki et al does not disclose receiving a path and a name of the file to be delivered from the client to the server for printing.

Hidaka et al disclose receiving a path and a name of the file to be delivered from the client to the server for printing (column 32, lines 51- 59; column 10, lines 6-10).

Suzuki et al and Hidaka et al are combinable because they are in the similar problem area of printing of files.

At the time of the invention, it would have been obvious to a person of ordinary skill in the art to combine file name/path specification of Hidaka et al with the print system of Suzuki et al to implement printing of file by a server using path name and file name.

The motivation to combine the reference is clear because the path and file name is needed to identify a specific file for printing.

4. Claim 2, 8, and 14 rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 6606163 to Suzuki et al in view of U.S. Patent No. 6782402 to Hidaka et al further in view of U.S. Patent Application Publication No. US 2002/0083341 A1 to Feuerstein et al.

Regarding claims 2, 8, and 14, Suzuki et al teach all the limitations of claims 1, 7, and 13 respectively. Suzuki et al performs comparison of file format, however Suzuki et al does not disclose the method of claim 1 wherein the name of the file includes an extension and wherein discovering the file type includes:

- (a) comparing the extension of the file to a list of print ready extensions; and ,
- (b) responsive to a match between the extension of the file and a print ready extension, realizing the file type is print ready.

Feuerstein et al disclose method of comparing file extensions with a list of valid file extension (page 4, paragraph 53).

Suzuki et al, Hidaka et al and Feuerstein et al are combinable because they are in the similar problem area of printing of files.

At the time of the invention, it would have been obvious to a person of ordinary skill in the art to combine file extension comparison of Feuerstein et al with the print system of Suzuki et al in view of Hidaka et al to implement file extension based printing of files.

The motivation to combine the reference is clear because the file extension is used to describe the type of file thus the extension is needed to determine if it is print ready file.

5. Claims 3, 9, and 15 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 6606163 to Suzuki et al in view of U.S. Patent No. 6782402 to Hidaka et al further in view of U.S. Patent No 6650431 to Roberts et al.

Regarding claims 3, 9, and 15, Suzuki et al teaches all the limitations of claim 1, 7, and 13 respectively. However Suzuki et al does not disclose method, system, and program for discovering the file type by analyzing contents of the file.

Roberts et al disclose method, system, and program (column 24, lines 36-67) for discovering the file type by analyzing contents of the file (Figure 2, reference 204, 206,208; column 8, lines 14-34).

Suzuki et al, Hidaka et al, and Roberts et al are combinable because they are in the similar problem area of printing of files.

At the time of the invention, it would have been obvious to a person of ordinary skill in the art to combine file content analysis of Roberts et al with the print system of Suzuki et al in view of Hidaka et al to implement file content based method of discovering print ready files.

The motivation to combine the reference is clear because some files have code inside the file which determines the file type thus it is necessary to examine the inside of the file.

6. Claims 4, 5, 10, 11, 16, and 17 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 6606163 to Suzuki et al in view of U.S. Patent No. 6782402 to Hidaka et al further in view of U.S. Patent No. 5963641 to Crandall et al.

Regarding claims 4, 10, and 16, Suzuki et al teach all the limitations of claims 1, 7, and 13 respectively. However Suzuki et al does not disclose method, system, and program to implement the method, system, and program of claims 1, 7, and 13 further including:

- (a) analyzing contents of the file to discover elements irresolvable by a printer; and
- (b) resolving the elements of the file irresolvable by the printer.

Crandall et al discloses an apparatus and computer program to implement the

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method of analyzing contents of print files for irresolvable elements such as fonts, images, and patterns and correcting them (column 1, lines 50-52, column 1, lines 28-35, column 2, lines 2-4).

Suzuki et al, Hidaka et al, and Crandall et al are combinable because they are in the similar problem area of printing of files.

At the time of the invention, it would have been obvious to a person of ordinary skill in the art to combine the analysis of irresolvable elements of Crandall et al with the print system of Suzuki et al in view of Hidaka et al to implement printing with correction of irresolvable elements.

The motivation to combine the reference is clear because Crandall et al teaches that before printing a check needs to be performed to make sure all the elements can be printed (column 1, lines 28-35).

Regarding claims 5, 11, and 17, Suzuki et al in view of Hidaka et al further in view of Crandall et al teach all the limitations of claims 4, 10, and 16. Further Crandall et al disclose the method of claim 4 wherein the elements irresolvable by the printer include fonts, images, and patterns irresolvable by the printer (column 1, lines 50-52; column 1, lines 28-35; column 2, lines 2-4).

7. Claims 6, 12, and 18 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 6606163 to Suzuki et al in view of U.S. Patent No. 6782402 to Hidaka et al further in view of U.S. Patent No. 6268924 to Koppolu et al.

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Regarding claims 6, 12, and 18, Suzuki et al teaches all the limitations of claims 1, 7, and 13 respectively. However Suzuki et al does not disclose method, system, and program to open user interface for providing users with printing options.

Koppolu et al disclose method, system, and program to open user interface for providing users with printing options (Figure 5, reference 203; column 15, lines 41-45).

Suzuki et al, Hidaka et al, and Koppolu et al are combinable because they are in the similar problem area of printing of files.

At the time of the invention, it would have been obvious to a person of ordinary skill in the art to combine the user interface taught by Koppolu et al with the print system of Suzuki et al in view of Hidaka et al to implement options for users to select before printing.

The motivation to combine the reference is clear because printer users need options to select before printing.

Other Prior Art Cited

8. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

U.S. Patent No. 6934044 to Khandelwal disclose an apparatus for network printing.

U.S. Patent Application Publication No. US 2005/0105126 A1 to Kawakami et al disclose ordering system with client/server.

Conclusion

9. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Beniyam Menberu whose telephone number is (571) 272-7465. The examiner can normally be reached on 8:00AM-4:30PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kimberly Williams can be reached on (571) 272-7471. The fax phone number for the organization where this application or proceeding is assigned is **571-273-8300**.

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Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the customer service office whose telephone number is (571) 272-2600. The group receptionist number for TC 2600 is (571) 272-2600.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only.

For more information about the PAIR system, see <http://pair-direct.uspto.gov/>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Patent Examiner

Beniyam Menberu

BM

10/14/2005


KIMBERLY WILLIAMS
SUPERVISORY PATENT EXAMINER